

REMARKS

This is in response to the Office Action mailed September 11, 2008. This response is being submitted with a 3 month extension of time.

Claims 1-2, 4-12, 85, 96-102, 104-105 and 108 are pending and stand rejected under 35 U.S.C. 103(a) based on obvious combination of U.S. Patent No. 6,847,965 (“Walker”) in combination with Business Wire article (“Air France”), whereas some claims are noted as further requiring the combination with a third reference, the article “Golden Boutique Set to Boost MAS Revenue” (“Ong-Yeoh”). Applicant respectfully disagrees and submits these rejections are improper as the claims are patentable in view of the prior art of record.

Applicant submits the present response as a final measure to avoid the delay of instigating the patent appeal process under 37 C.F.R. s41.37. Applicant notes that the present application has a current pendency in excess of eight (8) years, as this application was originally filed in December 2000. Applicant has been denied follow-up telephonic discussions with the Examiner, where Applicant merely wishes to acquire rightful patent protection duly afforded under the 35 U.S.C. ss101-103.

In the previous Preliminary Amendment filed June 30, 2008, Applicant made further claim revisions in the attempt to satisfy the Examiner’s interpretation of the prior art and in response, the Examiner not only does not address Applicant’s positions, but also improperly relies on “Official Notice” to paint an improperly broad stroke to support the asserted rejection.

I. No Response to Arguments

Beginning on page 5 of the present Office Action, the Examiner states “Applicant’s arguments ... have been considered but are moot in view of the new ground(s) of rejection.”

Applicant asserts confusion because there is no new “ground(s) of rejection.” In fact, the pending claims are rejected under the same identical grounds as before, the Walker / Air France combination.

On page 14 of the Preliminary Amendment, Applicant asserted:

Nothing in the prior art recognizes this opportunity for synergy. The Examiner relies on Walker as showing the traditional “buy one get one free” model. Walker does not however, show a specific pricing determination for one or both items based on the savings of all or a portion of a concession fee charged by a passenger carrier for the sale or delivery of a duty free item.

Applicant asserts confusion as to the Examiner’s omission to address this position. Applicant, in continuing the prosecution of the pending application in excess of eight (8) years submitted claim amendments in a Preliminary Amendment in conjunction with a Request for Continued Examination, paying additional fees for the continued examination. Applicant has not received that examination because Applicant’s position has not been given consideration. Rather, the Examiner asserts the broad position that this position is “moot,” which is clearly incorrect.

As such, Applicant re-iterates the above position regarding the failure of the prior art to recognize an opportunity for synergy and that Walker’s “buy one get one free” fails to teach or suggest a specific pricing determination for one or both items based on the savings of all or a portion of a concession fee charged by a passenger carrier for the sale or delivery of a duty free item.

Should the Examiner maintain the present rejection, Applicant respectfully demand that the Examiner address the above-offered position such that Applicant can prepare a proper response for the subsequent Appeal process.

II. The Examiner makes an improper leap from “discount” on duty free items to the recited limitations

On page 3 of the present Office Action, the Examiner states:

With respect to the first item being an international travel ticket and the second item being a duty free item. Air France teaches customer purchasing an international ticket being offered discounts for duty free items. It would have been obvious to a person of ordinary skill in the art at the time of Applicant’s invention to have included in the invention of Walker international tickets and duty free items in order to motivate customer to buy international flights.

Applicant asserts confusion because the Examiner makes an improper leap from the generalized notion of the “buy one get one free” concept of Walker and the duty free discount concept of Air France to the recited “offering to sell a customer, over a computer network, a specific international travel ticket for travel with a first passenger carrier at a discounted price and one or more specific duty free items.”

The Air France article states the basic notion that if a person purchases the \$428 fare, they will receive a bunch of items as part of the “welcome bonus,” including a “shopping discount voucher” at a duty free shop. Stated another way, the Air France reference “teaches” that if you buy one item, you get a second item for free, that second item is a coupon for a discount at another store. At best, Air France modifies the buy one get one free concept of Walker. Under the Air France system, the bought “one” is not the same as the free “one,” instead the bought “one” is a plane ticket and the free “one” is a discount voucher, which necessarily requires the person to make another purchase to realize any benefit of the airline ticket purchase.

The Examiner's assertion ignores the exact language of the claim, including the language of "offering to sell ... a specific international travel ticket ... and one or more specific duty free items." There is no teaching of Air France for the sale of a duty free item. At best, Air France offers the customer a discount voucher in combination with the purchase of the economy-fare airline ticket.

For further differentiation, under the Air France teaching, the customer purchases the airline ticket and then must make another, separate purchase to take advantage of the discount voucher. The free giveaway of a discount voucher, in no way shape or form, teaches or suggests "offering to sell a customer, over a computer network, a specific international travel ticket for travel with a first passenger carrier at a discounted price and one or more specific duty free items." (emphasis added)

Therefore, there is no reasonable leap to assert that "It would have been obvious ... to have included ... international tickets and duty free items in order to motivate customer to buy international flights." Stated succinctly, Air France does **not** teach or suggest the sale of a duty free item with an airline ticket. Rather, Air France teaches the offer of a discount voucher that can be used to then purchase a duty free item. It is improper to make the assumption that Air France teaches the sale of **both** an airline ticket and a duty free item.

Under the Air France system, the customer must make an additional purchase to realize the same benefits recited under the claimed invention. The combined systems of Walker and Air France would provide hidden or stealth costs, proving extremely unfair to customers. As recited, the customer is offered both the airline ticket and a duty free item. This is significantly separate and distinct from the Air France / Walker combination

which would require the customer to purchase the airline ticket at a first price, and then have to spend even more money to fully realize the benefits, spending the additional money at the Duty Free shop.

The disconnect between the voucher itself being an invitation to make a sale and an actual sale and delivery of a duty free item illustrates the impropriety of the present rejection as applied to various claim limitations. For example, claim 1 recite:

in conjunction with said offer to sell said specific international travel ticket at said discounted price, requiring said customer to select for purchase as part of a single transaction both the specific international travel ticket and at least one specific duty free item to be delivered to the customer at or near an exit point or on board the passenger carrier ... said merchant having arranged with the first passenger carrier for delivery of the least one duty free item to said customer during the travel associated with said specific international travel ticket

Applicant further notes Air France's "voucher" being an invitation for a secondary purchase necessarily fails to teach or suggest the recited "requiring said customer to select for purchase as part of a single transaction both the specific international travel ticket and at least one duty free item."

It would not have been obvious to one having ordinary skill in the art to combine Air France and Walker, because the combination would be a dangerously deceptive trade practice of misleading customers about the true costs of the "offer." This is in direct contradiction to the expressly recited limitations claimed herein.

Should the Examiner maintain the present rejection, Applicant requests the Examiner address the above-offered position such that Applicant can prepare a proper response for the subsequent Appeal process.

III. Examiner's Official Notice overlooks the exact claim language recited herein

Beginning on the final paragraph of page 3 of the present Office Action extending on to page 4, the Examiner improperly paints too broad of a stroke in asserting the "Official Notice" reasoning for supporting the present rejection.

In claim 1, by way of example, Applicant previously amended the present claim to recite:

...said merchant having arranged with the first passenger carrier for delivery of the at least one specific duty free item to said customer during the travel associated with said specific international travel ticket without the merchant being required to pay at least a portion of a concession fee otherwise charged by the first passenger carrier to merchants for selling or delivering such duty free items.

In supporting this rejection, the Examiner maintains the same Walker / Air France combination and simply adds an "Official Notice" statement. Applicant strenuously objects.

To avoid any confusion, Applicant notes that the Examiner states:

Official Notice is taken that it is old and well known for merchants and the like to negotiate an agreement with a manufacturer, host, provider of a goods and service and to pass all or some of the savings that result from said agreement to the customer. For example, Costco ® is a wholesaler corporation which buys in bulk at a discount and passes some of the savings to their members. It would have been obvious in the combination of Walker and Air France to have included the teachings of the well known business method of passing on some or all of the savings negotiated to the customers in order to provide the customer with discount and hopefully increase sale.

As understood, the Examiner makes the assertion that the basic concept of a buying in bulk and passing bulk savings to the customer is the same thing as the recited limitation quoted above. Applicant respectfully disagrees.

The Examiner's Official Notice and supporting statement (quoted above) overlooks the exact claim language. Applicant does not claim a bulk purchase or a negotiated agreement with a manufacturer and the passing of those savings to customers. Rather, the exact claim language recites "said merchant having arranged with the first passenger carrier for delivery of ... the duty free item to said customer ... without the merchant being required to pay at least a portion of a concession fee." Moreover, the claimed "concession fee" is a fee that is "otherwise charged by the first passenger carrier to merchants for selling or delivering such duty free items."

The notion of bulk sales and passing savings to customers is completely inconsistent with the merchant having an arrangement for duty free item delivery without the merchant being required to pay a concession fee. First off, the Examiner overlooks the claimed "concession fee" relating to a duty free item delivery. Secondly, the Examiner makes an illogical connection between a bulk rate or a saving being passed on to the customer and the merchant not "being required to pay at least a portion of a concession fee." The claims do not recite any passage of savings to customers.

The Examiner's assertions supporting the present rejection ignore the **exact language of the claims**. Again, as noted with respect to the position above, the Examiner misreads the claims and assumes elements not within the claims themselves. In supporting the assertion that the Costco business model renders the claim obvious, the Examiner assumes that a single merchant negotiates a discount from a supplier and passes savings on to clients based on the bulk purchase. The claim recites "requiring said customer to select for purchase as part of a single transaction both the specific international travel ticket and at least one specific duty free item," where the offer to sell

the international travel ticket is offered “at a discount price.” There is no support for the Examiner’s assertion that the “savings” of the “discounted” price are based on the “concession fee.” Rather, the recited claim expressly notes a relationship that allows “the merchant to sell the specific international ticket at the discount price.” Stated another way, the claims recite the setting of the discount price of the travel ticket based on the dollar value of the duty free item, and concession fee portion not being paid defines a sufficiency level that allows for the sale of the ticket.

Applicant further notes the applicability of the above-offered position in Section II above as applicable to the exact claim language of: “wherein said merchant determines the discount price of said specific international travel ticket based at least in part on a dollar value of one or more duty free items which **are or must be purchased** from the merchant” (emphasis added). The Examiner’s logic and “Official Notice,” in conjunction the teachings of Air France fail to address the exact claim language noting that the discount price is “based at least in part on a dollar value of one or more duty free items which are or must be purchased.” The Air France teaching of a voucher is only an invitation for the sale of an item. The cost of the Air France ticket is totally unrelated to any actual duty free item purchase, rather when purchasing the Air France ticket, you get a voucher that **can** be used for the purchase of whatever duty free item the traveler chooses, **if** the traveler chooses to actually even purchase anything, i.e. the traveler can skip the duty free shop altogether, which is entirely contrary to the exact claim language recited herein.

Should the Examiner maintain the present rejection, Applicant requests the Examiner address the above-offered position such that Applicant can prepare a proper response for the subsequent Appeal process.

IV. The “voucher” of the Air France disclosure is not tied to any specific international travel ticket

For further illustration of the irreconcilable differences between the Air France system and the claimed invention, it is noted that Air France “voucher” is not tied to the present itinerary associated with an international travel ticket.

Air France explicitly notes that with the purchase of a round-trip economy-class fare of \$428, the passenger receives a discount voucher good in the duty free shops at Charles de Gaulle airport. The exact language of Air France is that a person receives a voucher and as noted above in section II, the voucher is not a duty free item, but rather an enticement **to make** a purchase of a duty free item, e.g. the passenger having to make a complete, separate and distinct financial transaction.

The disconnect between the voucher itself being an invitation to make a sale and an actual sale tied to a specific international travel ticket illustrates the impropriety of the present rejection as applied to various claim limitations. Claim 1 recites:

in conjunction with said offer to sell said specific international travel ticket at said discounted price, requiring said customer to select for purchase as part of a single transaction both the specific international travel ticket and at least one specific duty free item to be delivered to the customer at or near an exit point or on board the passenger carrier ... said merchant having arranged with the first passenger carrier for delivery of the least one duty free item to said customer during the travel associated with said specific international travel ticket

The discount voucher is not tied to a particular itinerary, for example the passenger is not required to purchase anything from the duty free shop at all, much less on that particular trip. This therefore fails to teach or suggest the delivery of the duty free

item “to said customer during the travel associated with said specific international travel ticket.” The discount voucher is not associated with the international travel ticket, and as such Air France does not teach or suggest such limitation.

Should the Examiner maintain the present rejection, Applicant requests the Examiner address the above-offered position such that Applicant can prepare a proper response for the subsequent Appeal process.

V. The Examiner improperly relies on “Office Notice” to support assertions noted as occurring “nowadays” in view of the December 2000 filing date

On page 4 of the Office Action, the Examiner states that:

With respect to delivering the duty free items at or near an exit point, the Examiner wants to point out that delivering the duty free items near the exit is the norm at airports in order to assure that duty free merchandises [sic] are consume [sic] outside the country which sold the items. It would have been obvious to a person of ordinary skill in the art at the time of the Applicant’s invention to have included delivering and locating the duty free shops near an exit point as being done by major airports nowadays [sic] in order to obtain the above mentioned advantage.

Applicant reminds the Examiner that the standard for examination is based on the priority claim of the pending application. This application was filed in December, 2000. Therefore, the Examiner’s reliance on what major airports are doing “nowadays” is not only incorrect but also improper.

The Examiner is required to take Official Notice or provide actual support that predates the Applicant’s filing date. The Examiner cannot properly support the present assertion based on Official Notice relating to “nowadays.”

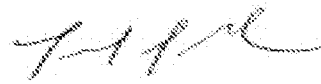
As such, in order to maintain the present rejection, Applicant respectfully requires support for the Examiner’s assertions that the “norm at airports” was the “norm at airports” prior to Applicant’s 2000 filing date. Should the Examiner maintain the present

rejection, Applicant requests the Examiner address the above-offered position such that Applicant can prepare a proper response for the subsequent Appeal process.

For at least all of the above reasons, Applicant respectfully requests that the Examiner withdraw all rejections, and allowance of all the pending claims is respectfully solicited. To expedite prosecution of this application to allowance, the Examiner is invited to call the Applicant's undersigned representative to discuss any issues relating to this application.

Respectfully submitted,

Dated: March 9, 2009



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